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OFFICE OF PETITIONS

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In re Application of
Ohsumi et al.
Application No. 10/692,738
Patent No. 6,908,905
Filed: October 27, 2003
Attorney Docket No. 244118USOC0NT

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: DECISION DISMISS PETITION
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This decision is in response to Applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT under (37 CFR 1.705(d))" filed on August 22, 2005 requesting that the Office adjust the PTA determination at the time of the mailing of the notice of issuance from a determination of 62 days to a determination of ninety-four (94) days.

Applicants application for PTA is **DISMISSED**. Applicants are given **thirty** days to respond to this decision. No extensions of time will be granted under 37 CFR 1.136. Any response should be directed to Mail Stop Petitions.

Applicants assert that the Office erred in assessing a forty-eight day reduction under 37 CFR 1.704(c)(10) for the submission of a European Search report as "an other paper" within the context of 37 CFR 1.704(c)(10). In addition, applicants further assert that their filing should be considered within the safe harbor of 37 CFR 1.704(d).

A review of the file reflects that applicants' arguments are not persuasive. Contrary to applicants assertion that the submission of the European search report would not be considered a failure to engage in reasonable to conclude prosecution of the application, the submission of such disclosure is considered a failure to engage in reasonable efforts to conclude processing and examination of the application under 37 CFR 1.704(c)(10). It is clear from rule 37 CFR 1.704(d) that the disclosure would be considered a failure to engage under 37 CFR 1.704(c)(10). Accordingly, the IDS was not enumerated in 1247 OG 111 notice cited by applicants. Note that 1.704(d) which provides a safe harbor for IDS submission expressly notes that an IDS is a reduction under 37 CFR 1.704(c)(10) UNLESS there is a specific statement meeting all of the language of 1.704(d).

Applicants have not met the required statement. 37 CFR 1.704(d) requires the following statement:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.197 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the


information disclosure statement. This thirty-day period is not extendable.

Applicants applying for such exception must mirror the language in the rule to meet this qualification. Moreover, applicants should consider who is a party within the meaning of 37 CFR 1.56(c) for PTA purposes. See questions and answers related to PTA posted on the following weblink; <http://www.uspto.gov/web/offices/dcom/olia/aipa/ptafaq.htm>

After mailing, this application will be held by the Office of Patent Legal Administration to wait for any response by applicant.

The Office has assessed the \$200.00 fee. No additional fees are required in this deciding this application.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy, at 571-272-7757.



Kery Fries
Senior Legal
Office of Patent Legal Administration
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